

## **REMARKS**

### **I. Status of Claims**

The Applicants have carefully considered the Office Action dated January 20, 2011, and the references it cites. Currently, claims 1-12, 14-24 and 33-36 are pending in this application. The Examiner rejects:

- claims 1,3, 7, 9, 12, 15-16, and 20 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent Publication No. 2003/0222973 to Hiroi et al. (*Hiroi*);
- claims 2, 4-6, 10, 14, 17-19, 23, and 29-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hiroi* in view of U.S. Patent Publication No. 2002/0051181 to Nishimura (*Nishimura*);
- claims 8 and 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hiroi* in view of U.S. Patent No. 6,236,760 to Bagni et al. (*Bagni*);
- claims 11 and 24 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hiroi* in view of U.S. Patent No. 7,003,040 to Yi (*Yi*);
- claims 33 and 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hiroi* and *Nishimura* in further view of U.S. Patent Publication No. 2003/0112354 to Ortiz et al. (*Ortiz*); and
- claims 35 and 36 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ortiz* in view of *Nishimura*.

In response, the Applicants submit the foregoing amendments and the following remarks.

### **II. IDS filed on August 3, 2010**

In the Office Action, the Examiner alleges that Japanese reference no. JP2001-127847A was not considered because it does not have an English Abstract or English equivalent. Applicants duly note that U.S. Patent Publication No. 2003/050238 was listed as an equivalent in the Information Disclosure Statement. Accordingly, the IDS and all references were properly submitted and should be considered. *See MPEP § 609.04(a)(III)* (“An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information

*disclosure statement*"). Accordingly, Applicants request the Examiner to consider all references listed in the IDS filed on August 3, 2010.

In the Office Action, the Examiner cites to *MPEP* § 609.05(a), thereby presumably asserting that the IDS was not in compliance with U.S. Patent and Trademark Office procedures. However, as detailed above, the IDS was fully compliant. Applicants respectfully request the Examiner to consider all references listed in the IDS filed on August 3, 2010.

### **III. Claim Rejections Under 35 U.S.C. § 102(b)**

Claim 1 recites an apparatus for transmitting a signal of a moving image in a mobile communication terminal capable of reproducing the moving image comprising, *inter alia*, a first receiver for receiving a communication signal; a second receiver for receiving a television signal; an input section for generating signals for capturing and transmitting the television signal; and a control section for receiving, according to the signals generated by the input section, a command signal for capture and transmission of the television signal, and controlling to capture and transmit a portion of the television signal while a moving image associated with the television signal is displayed.

In the Office Action, the Examiner contends that the video input unit 505 is analogous to a second receiver. Applicants disagree because the "video input unit 505 includes, for example, a camera to input an external video image to the terminal device." See *Hiroi at [0055]*. That is, *Hiroi* describes generating an image signal via the camera. That is, the image signal is not received via a receiver. Rather, a camera generates an image signal. Thus, *Hiroi* does not teach or suggest a second receiver for receiving a television signal as recited in claim 1. Thus, *Hiroi* also fails to teach the input section and the control section as claimed.

Further, *Ortiz* and/or *Nishimura* does not cure at least the above-noted deficiencies of *Hiroi*. Thus, for at least the foregoing reasons, claim 1 and all claims dependent therefrom would not have been obvious from *Ortiz* applied alone or in any reasonable combination with *Nishimura* and/or *Yi*. Further, claims 12 and all claims depending therefrom are patentable over the cited art for at least substantially the same reasons set forth above in connection with claim 1.

#### **IV. Claim Rejections Under 35 U.S.C. § 103(a)**

Claim 33 recites an apparatus for transmitting a television signal in a mobile communication terminal capable of receiving the television signal comprising: an input section for generating signals for capturing and transmitting a received television signal; a control section for generating, according to the signals generated by the input section, a command signal for capture and transmission of the received television signal, the control section controlling to capture and transmit a portion of the television signal while the received television signal is displayed; a memory for storing the television signal captured according to a capture command generated by the control section; and a transmission section for transmitting the captured image stored in the memory.

In the Office Action, the Examiner acknowledges that *Hiroi* does not teach or suggest a television signal and relies on *Ortiz* to cure this deficiency. The Examiner states that it would be obvious “to modify *Hiroi*’s system with the capability of receiving television broadcast signals as taught by *Ortiz*, so as to provide an enhanced system capable of receiving television signal in order to improve the user’s viewing experience.” The Examiner specifically states that “*Ortiz* is used only to disclose the teaching of a mobile communication terminal being able to receive a television broadcast signal.” See the final Office Action at p. 4.

Applicants submit that neither *Ortiz* nor *Hiroi* are related to controlling to capture and transmit a portion of the television signal while the received television signal is displayed. Although *Hiroi* generating a video data and transmitting the video data to a destination device, *Hiroi* is not related to receiving a television signal and does not teach or suggest a control section controlling to capture and transmit a portion of the television signal while the received television signal is displayed. That is, the alleged combination may arguably receive the signal, but there is no reason to make the alleged combination capture and retransmit a captured signal. If there is any reason to, Applicants submit that such motivation is provided from Applicants own specification and is improper hindsight bias.

Meanwhile, *Hiroi* teaches acquiring, displaying, capturing, encoding and transmitting a video. However, as illustrated in steps 707-711 of Fig.5 of *Hiroi*, it is noted that the above operations are a sequential operation flow. In other words, *Hiroi* teaches that the operations of displaying, capturing and transmitting can be performed along with the other processes.

But, it means other application programs or other processes are performed besides a video telephony, and does not mean that the operations of displaying, capturing and transmitting are simultaneously performed.

Therefore, *Hiroi* fails to teach "controlling to capture and transmit a portion of the television signal while a moving image associated with the television signal is displayed" as recited in claim 1 and "wherein the step of reproducing the television signal is performed simultaneously with the steps of capturing and transmitting the image" as recited in claim 12.

Thus, for at least the foregoing reasons, claims 33 and 35 and all claims dependent therefrom would not have been obvious from *Hiroi* applied alone or in any reasonable combination with *Ortiz*.

## **V. Conclusion**

The Applicants submit that the above amendments and arguments are fully responsive to the Office Action dated January 20, 2011. Further, the Applicants submit that, for at least the foregoing reasons, all pending claims are in condition for allowance and notice to that effect is requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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